



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Typed or printed name

Martin Wolff

Application Number

10/081,095

Filed

2/22/02

First Named Inventor

Loewenstein, David

Art Unit

3711

Examiner

Collins

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the



applicant/inventor.



assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)



attorney or agent of record.

Registration number 35 591



attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

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Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Loewenstein
Serial No. : 10/081,095
Filed : 02/22/2002
Title : CARDS AND CARD GAME
Examiner : Collins
Art Unit : 3711

PRE-APPEAL BRIEF REQUEST FOR REVIEW

I. Application History

The application was filed over five years ago, on February 22, 2002. After two non-final rejections, a third and final rejection was sent on November 28, 2003.

Applicant filed a Notice of Appeal on February 27, 2004. Prosecution was then reopened with a non-final rejection on June 30, 2004. Following a teleconference with the Supervisory Examiner on June 20, 2005 on co-pending application 10/418,829 ("the '829 Application"), Applicant submitted an amendment on July 25, 2005. On April 21, 2006, a Notice of Allowance was issued. The issue fee was paid on this application and the '829 Application.

On November 7, 2006, a Notice of Withdrawal was issued. Most recently, a non-final rejection was sent on February 5, 2007 based on a 35 U.S.C. § 101 for a lack of "tangible outcome to the method of play." This was the first time the claims had ever been rejected under 35 U.S.C. § 101.

As explained in more detail below, this rejection is flatly inconsistent with 35 U.S.C. § 101. The Examiner made a serious error of law.

Because the application has been rejected more than twice, applicant is permitted to appeal to the Board of Patent Appeals and Interferences. 35 U.S.C. § 134 (a).

II. The Invention

This invention and co-pending continuation in part, '829 Application, relate to an entirely new type of playing cards and games that use them.

The inventive cards when first dealt to a player, show only the suit (e.g., hearts, diamonds) but not the rank (Ace, 10 Jack, etc). When the player selects a card, the card is transformed as both the suit and rank appear. The claims recite methods for playing poker and other card games with these inventive cards. After over five years of prosecution, none of the examiners and supervisory examiners has found playing cards like these novel cards. All previous cards have both the rank and suit displayed together at all times.

The novelty of these cards permits the creation of entirely new card games that by definition never existed because the cards themselves did not exist.

III. Discussion

The basis for rejection under 35 U.S.C. § 101 was a simply conclusory statement:

“there is no tangible outcome to the claimed method of play. The claims appear to be merely a series of abstract ideas with no concrete, tangible result.”

This is both factually false and directly inconsistent with the law.

The law is, and has been, for over a quarter century:

“‘The Supreme Court has construed § 101 broadly, noting that Congress intended statutory subject matter to “include anything under the sun that is made by man.”’”

See Diamond v. Chakrabarty, 447 U.S. 303, 309 (1980) . . . see also Diamond v. Diehr, 450 U.S. 175, 182 . . . (1981).” AT&T Corp. v. Excel Comm., 172 F.3d 1352, 1355 (Fed. Cir. 1999). Similarly, the Federal Circuit has held:

“The notion of ‘physical transformation’ can be misunderstood. In the first place, it is not an invariable requirement, but merely one example of how a mathematical algorithm may bring about a useful application. As the Supreme Court itself noted, ‘when a claimed invention is performing a function which the patent laws were designed to protect (e.g., transforming or reducing an article to a different state or thing), then the claim satisfies the requirements of § 101.’”

AT&T at 1358 -59 (citation omitted).

MPEP § 2106.11.A is the same (citations omitted):

“The claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a ‘useful, concrete and tangible result.’ The purpose of this requirement is to limit patent protection to inventions that possess a certain level of ‘real world’ value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research.”

Section 101 rejections are very limited, and generally relate to patent claims that try to cover laws of nature or algorithms that are not patentable. By stark contrast, the inventions at issue here are not close to those that have been condemned under section 101 -- they relate to tangible things, with “‘real world’ value” -- novel playing cards and games that use them.

As a check on this conclusion, the Examiner should consider the definition of “intangible” found on the internet: “1. Incapable of being perceived by the senses. 2.

Incapable of being realized or defined. 3. Incorporeal.” None of these definitions describe the claimed inventions. <http://www.thefreedictionary.com/intangible>.

The claimed playing cards, the electronic representations of playing cards, and games all can be perceived and can - and have been defined. There is nothing “[in]tangible” about them. Indeed, the fact that several examiners, over a period of five years, were able to compare the claims to the prior art further demonstrates this is true. If the claim described something wholly intangible - what did the various examiners compare to them? Plainly, these claimed inventions are perceptible, and were properly defined.

Moreover, there is a tangible outcome recited in each of the independent claims, and therefore for all the claims, because the dependent claims incorporate all the limitations from the independent claims. Each of the independent claims expressly recites the transformation of the playing cards’ appearance: when the cards are first dealt they show only the cards’ suits (not their ranks), only after a card is selected, do both the suit and rank of the selected card appear. Changing the cards’ appearance after they are selected -- the critical distinction of the claimed inventions -- is a concrete and easily observable manifestation of the invention. The cards change fundamentally from providing only partial information to providing complete information about the selected card. According to the Federal Circuit, “transforming or reducing an article to a different state or thing ... satisfies the requirements of § 101.” AT&T at 1358-59. Nothing more is required.

Therefore, the rejection under 35 U.S.C. § 101 is both legally and factually incorrect.

Claim 19 further demonstrates the error in Examiner's conclusion. The claim delineates five steps in the method as: dealing cards, only the suit appearing on each card, allowing a player to select cards to form a poker hand, both the suit and rank appearing, comparing the resulting hand to a pay table, and paying the player according to the pay table. Contrary to the statement in the Office Action, this is not "a series of abstract ideas" because each claim limitation is a tangible step for playing a novel video poker game.

Finally, the limitation recited in several claims (e.g., 3 -5, and 19, 22 - 24): "a player is paid off according to a pay table," is certainly not merely an abstract idea as the Examiner asserted. Again, this is a real demonstrable, tangible, occurrence.

IV. Conclusion

For the foregoing reasons, the Examiner's rejections are wrong as a matter of law and fact, and the claims are in condition for allowance.

Respectfully submitted,



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